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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,723	05/20/2005	Manuel Vangelisti	P/3610-59	9221

2352 7590 05/25/2006

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/535,723

Applicant(s)

VANGELISTI, MANUEL

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/05/19/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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Detailed Action

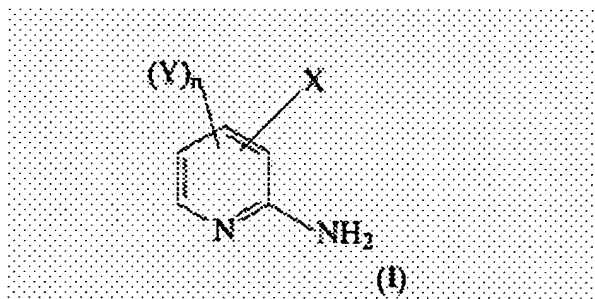
Claim 1 is objected to because it does not have a period at the end of the claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

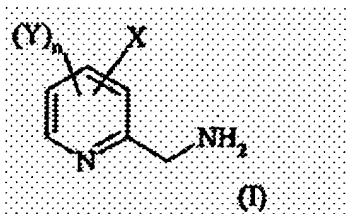
Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe a process

of forming the compound of



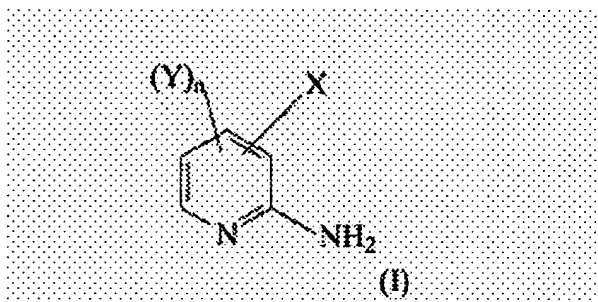
but of the

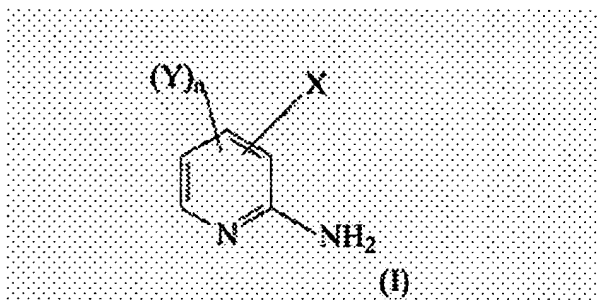
compound of formula



in the claims filed 5/20/05. The process

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of forming a compound of  is new matter and appears to be an inadvertent mistake on the applicant's part.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-101646. (See Reference N).

JP 10-101646 teaches the process of hydrogenating the compound of formula I wherein X is halogen to get the final compound of formula 2 wherein X is halogen, and this process takes place in ammonia in the presence of a catalyst containing manganese. The difference between the prior art process and the instantly claimed process is the teaching of a generic process which overlaps in subject matter with the instant process of producing the final compound regarding the X moiety of the reactants and products. In the prior art process, X can also be hydrogen, whereas in the instant process, X cannot be hydrogen.

The patentee teaches a very limited number of selections for the variables of this genus that are small enough in number to be combined to form the instant genus.

Since the patentee teaches a process of making small group of compounds within a genus that overlaps in subject matter with the instant process of preparing the instant genus, it would have been obvious for one of ordinary skill in the art to easily envision and test the compounds that overlap with the prior art genus of compounds.

Accordingly, the process is deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed process over those of the generic prior art process.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2,3, 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Dann et. al. (Reference O, WO0216322) Dann et. al. discloses the instant process of preparing aminomethylpyridines of the compound of general formula I comprising the catalytic hydrogenation of a compound of general formula II, wherein X is halogen, Y, which may be the same or different is halogen, haloalkyl, alkoxycarbonyl, or alkylsulphonyl, and n is 0 to 3. At page 12, see claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dann et. al. (See Reference O).

Dann et. al. (WO0216322) teaches the process of preparing aminomethylpyridines of the compound of formula I which is performed at 0 to 60 degrees Celsius. At claim 12, page 13, see the Dann process. The difference between the prior art process and the instantly claimed process is the teaching of the process of preparing aminomethylpyridines of the compound of formula I which is performed at a temperature from 0 to 60 degrees Celsius which encompasses the range of the Temperature of from 35 to 50 degrees Celsius which the instant process occurs at. It would have been obvious to one of ordinary skill in the art perform this process of preparing aminomethylpyridines of the compound of formula I which is performed at temperature from 35 to 50 degrees Celsius, which is a range inside of the prior art Temperature range at which the prior art process occurs. One of ordinary skill in the art would have recognized the suitability of adjusting the prior art ranges to reach the claimed ranges. See *In re Harris*.

Accordingly, the instant process is deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed process over those of the prior art process.

Claim 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dann et. al. (See Reference O, WO0216322).

Dann et. al. teaches the process of preparing aminomethylpyridines of the compound of formula I which is performed at a hydrogen pressure of from 1.01295 bar to 4.0516 bar. At claim 13, see the Dann process. The difference between the prior art process and the instantly claimed process is the teaching of the process of preparing aminomethylpyridines of the compound of formula I which is performed at a pressure of hydrogen that is chosen from 1.01295 bar to 4.0516 bar rather than from 2 to 30 bar as claimed in instant claim 9. It would have been obvious to one of ordinary skill in the art to perform this process of preparing aminomethylpyridines of the compound of formula I which is performed at a range of pressures of from 2 to 30 bar which overlaps, the prior art pressure range at which this process is performed. One of ordinary skill in the art would have recognized the suitability of adjusting the prior art ranges to reach the claimed ranges. See *In re Harris*.

Accordingly, the instant process is deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed process over those of the prior art process.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 11-12 contain the trademark/tradename Raney nickel. Where a trademark or trade name is used in a claim as a limitation to identify or describe particular material or product, the claim does not comply with the requirements of 35 U. S. C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify the source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a nickel catalyst, however, it is not clear which nickel catalyst is described, since "Raney Nickel" can describe several nickel catalysts, and accordingly, the identification/description is indefinite.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Thomas McKenzie can be reached on 571-272-0670.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.


BMR
May 18, 2006


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